



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO-P-2016-0012]

Post-Prosecution Pilot Program

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice; request for comment.

SUMMARY: The United States Patent and Trademark Office (Office) is initiating a Post-Prosecution Pilot Program (P3) to test its impact on enhancing patent practice during the period subsequent to a final rejection and prior to the filing of a notice of appeal. This Pilot Program responds to stakeholder input gathered during public forums held in support of the Enhanced Patent Quality Initiative. Under the P3, a panel of examiners, including the examiner of record, will hold a conference with the applicant to review the applicant's response to the final rejection of record. In order to participate in the P3, the applicant will be required to file a request for consideration under the P3 within two months from the mailing date of a final rejection and prior to filing a notice of appeal, together with a response to the final rejection and a statement that the applicant is willing and available to participate in the conference. The applicant will have the option of including in the response a proposed non-broadening amendment to a claim(s). The Office designed the P3 to increase the value of after final practice by (1) leveraging

applicant input obtained through an oral presentation during a conference with a panel of examiners, and (2) also providing written explanation for the panel decision. The P3 is also designed to reduce the number of appeals and issues to be taken up on appeal to the Patent Trial and Appeal Board (PTAB), and reduce the number of Requests for Continued Examination (RCE), and simplify the after final landscape. This notice identifies requirements and procedures of the P3, which will govern entry into, and practice under, the P3. This notice also solicits public comments on the P3 and other suggestions to improve after final practice and reduce the number of both appeals to the PTAB and RCEs.

DATES: Effective Date: **[INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER].**

Duration: The P3 will accept requests beginning **[INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER]**, until either January 12, 2017, or the date the Office accepts a total (collectively across all technology centers) of 1,600 compliant requests to participate under the P3, whichever occurs first. Each individual technology center will accept no more than 200 compliant requests, meaning that the P3 may close with respect to an individual technology center that has accepted 200 compliant requests, even as it continues to run in other technology centers that have yet to accept 200 compliant requests.

Comment Deadline Date: Written comments must be received on or before November 14, 2016.

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to: afterfinalpractice@uspto.gov. Comments may also be submitted by postal mail addressed to: United States Patent and Trademark Office, Mail Stop Comments – Patents, Office of Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Raul Tamayo. Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet in order to facilitate posting on the Office’s Internet Web site.

The comments will be available for public inspection at the Office of the Commissioner for Patents, located at Madison Building East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office’s Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Raul Tamayo, Senior Legal Advisor (telephone (571) 272-7728; electronic mail message (raul.tamayo@uspto.gov)), Kery Fries, Senior Legal Advisor (telephone (571) 272-7757; electronic mail message (kery.fries@uspto.gov)), or Jeffrey West, Legal Advisor (telephone (571) 272-2226; electronic mail message (jeffrey.west@uspto.gov)). Alternatively, mail may be addressed to Raul Tamayo, Office of Commissioner for Patents, Attn: Post-Prosecution Pilot Program, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION:

I. Background

Since 2005, the Office has administered the Pre-Appeal Brief Conference Pilot Program (Pre-Appeal program), which provides an avenue for a patent applicant to request a review of the basis of a rejection(s) in a patent application prior to the filing of an appeal brief. See New Pre-Appeal Brief Conference Pilot Program, 1296 Off. Gaz. Pat. Office 67 (July 12, 2005). Specifically, when an applicant files a notice of appeal together with a request to participate in the Pre-Appeal program, a panel of examiners (including the examiner of record) formally reviews the rejections of record in light of the remarks provided in the request. The Pre-Appeal program benefits both the applicant and the Office. For example, if the panel's review determines that the application is not in condition for appeal, the applicant can save the time and expense of preparing an appeal brief, and the Office can save resources associated with an appeal to the PTAB.

Since 2013, the Office has administered the After Final Consideration Pilot Program 2.0 (AFCP 2.0). See After Final Consideration Pilot Program 2.0, 78 FR 29117 (May 17, 2013). Under AFCP 2.0, examiners consider a response filed after a final rejection pursuant to 37 CFR 1.116 that includes remarks and amendments that may require further search and consideration, provided that at least one independent claim includes a non-broadening amendment. The examiner also may conduct an interview with the applicant when the response does not place the application in condition for allowance. A goal of

AFCP 2.0 is to reduce pendency by reducing the number of RCEs and encouraging increased collaboration between the applicant and the examiner to effectively advance the prosecution of the application.

The P3 program implemented through this notice combines effective features from the Pre-Appeal and AFCP 2.0 programs with new features. For example, the P3 provides for (i) an after final response to be considered by a panel of examiners (Pre-Appeal), (ii) an after final response to include an optional proposed amendment (AFCP 2.0), and (iii) an opportunity for the applicant to make an oral presentation to the panel of examiners (new). Finally, the panel decision will be communicated in the form of a brief written summary. Section II of this notice provides a more complete identification of the requirements and procedures of the P3. This notice does not discontinue either the Pre-Appeal or AFCP 2.0 pilot programs.

II. P3 Participation Requirements and Procedures

A. P3 Participation Requirements

To be eligible to participate in the P3, an application must contain an outstanding final rejection and be (i) an original utility non-provisional application filed under 35 U.S.C. 111(a), or (ii) an international utility application that has entered the national stage in compliance with 35 U.S.C. 371 (see 37 CFR 1.491). A continuing application (e.g., a

continuation or divisional application) is filed under 35 U.S.C. 111(a) and is thus eligible to participate in the P3. Reissue, design, and plant applications, as well as reexamination proceedings, are not eligible to participate in the P3.

A request for a response under 37 CFR 1.116 to be considered under the P3 must include the following items: (1) A transmittal form, such as form PTO/SB/444, that identifies the submission as a P3 submission and requests consideration under the P3; (2) a response under 37 CFR 1.116 comprising no more than five pages of argument; and (3) a statement that the applicant is willing and available to participate in the conference with the panel of examiners. Optionally, a P3 request may include a proposed non-broadening amendment to a claim(s).

Only one P3 request will be accepted in response to an outstanding final rejection. If prosecution is reopened and the Office subsequently issues a new final rejection, the filing of a P3 request in response to the new final rejection is permitted. Once a P3 request has been accepted in response to a final rejection, no additional response under 37 CFR 1.116 to the same final rejection will be entered, unless the examiner has requested the additional response because the examiner agrees that it would place the application in condition for allowance.

There is no fee required to request consideration under the P3. All papers associated with a P3 request must be filed via the USPTO's Electronic Filing System-Web (EFS-Web).

To be eligible to participate in the P3, an applicant cannot have previously filed a proper request to participate in the Pre-Appeal program or a proper request under AFCP 2.0 in response to the same outstanding final rejection, and once a P3 request is accepted, neither a request to participate in the Pre-Appeal program nor a request for consideration under AFCP 2.0 will be accepted for the same outstanding final rejection.

1. Timing of the P3 Request

A P3 request must be filed within two months from the mailing date of a final rejection and prior to filing a notice of appeal. A P3 request will be deemed untimely if it is filed (i) more than two months from the mailing date of the final rejection, (ii) in an application that does not contain an outstanding final rejection (e.g., a P3 request will not be accepted in response to a second action non-final rejection), (iii) in response to a final rejection for which a proper AFCP 2.0 request has been filed, (iv) on or after the date a RCE or notice of appeal is filed in response to the same outstanding rejection, or (v) on or after the date an express abandonment is filed. For information on how the Office will process an untimely P3 request, refer to Section II.B.1 of this notice. For information on how a P3 request will be treated if a RCE, notice of appeal, or express abandonment is filed subsequent to the filing of the P3 request, but prior to a decision on the P3 request, refer to Section II.B.4 of this notice.

2. Transmittal Form

A P3 request must include a transmittal form. The Office advises the use of form PTO/SB/444, which is available at <http://www.uspto.gov/forms/index.jsp>, as the transmittal form. Use of form PTO/SB/444 will help the Office to quickly identify P3 requests and facilitate timely processing. In addition, form PTO/SB/444 will help applicants understand and comply with the requirements and procedures of the P3. Under 5 CFR 1320.3(h), form PTO/SB/444 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995.

3. Response under 37 CFR 1.116

A P3 request must include a response under 37 CFR 1.116. The response must be a separate paper from the transmittal form, and must comprise no more than five pages of arguments. Arguments are limited to appealable, not petitionable, matters (e.g., an argument that the final rejection was premature is a petitionable matter – see MPEP § 706.07(c)). The Office considers arguments as encompassing, e.g., conclusions, definitions, claim charts, and diagrams. If the applicant opts to include a proposed amendment in the response under 37 CFR 1.116, as further discussed at Section II.A.5 of this notice, arguments presented in the response may be directed to the patentability of the proposed amended claim(s). The sheet(s) of the response containing a proposed amendment will not count towards the five-page limit. If the applicant opts to include an affidavit or other evidence as part of the response, entry of the affidavit or other evidence

will be governed by 37 CFR 1.116. See MPEP 714.12. In addition, the affidavit or other evidence will count towards the limit of no more than five pages of arguments.

Form PTO/SB/444, or an equivalent transmittal that does not include arguments, will not count towards the five-page limit. Additionally, a page of the response that consists solely of, for example, a signature will not be counted toward the five-page limit. Thus, for example, a response that includes five pages of arguments and a sixth page that includes conclusions and/or definitions would be treated as exceeding the five-page limit. Furthermore, an applicant may not circumvent the five-page limit by filing arguments in multiple separate documents. For example, if an applicant files one document containing five pages of arguments and an additional document containing arguments, the two documents will be considered together to ascertain whether the five-page limit has been exceeded.

The response may be single spaced, but must comply with the requirements of 37 CFR 1.52(a). Additionally, the response may refer to an argument already of record rather than repeat the argument. This should be done by referring to the location of the argument in a prior submission and identifying the prior submission by title and/or date (e.g., see the argument at pages 4-6 of the paper titled “Applicant’s Response to Final Office Action” filed on October 1, 2015). A reference to “the arguments of record” or “the paper dated X” without a pinpoint citation will not be considered under the P3.

4. Conference Participation Statement

The P3 request must include a statement by the applicant that the applicant is willing and available to participate in the conference with the panel of examiners. Form PTO/SB/444 includes the required conference participation statement.

After the Office initially verifies that a P3 request is timely and compliant, as further discussed at Section II.B.1 of this notice, the Office will contact the applicant to schedule the conference. If within ten calendar days from the date the Office first contacts the applicant, the Office and the applicant are unable to agree on a time to hold the conference, or the applicant declines to participate in the conference, the request will be deemed improper and treated in accordance with the discussion at Section II.B.1 of this notice.

The applicant may participate in the conference in-person, by telephone, or by a video conferencing tool set up by the Office, such as WebEx®. The conference will permit the applicant to present to the panel of examiners in a manner similar to how an applicant presents an argument in an ex parte appeal before the PTAB. The applicant's participation in the conference will be limited to 20 minutes.

The applicant should advise the Office of any special needs as soon as possible before participating in a conference. Examples of such needs include an easel for posters or a projector. The applicant should not make assumptions about the equipment the Office

may have on hand for the conference. Section II.B.2 of this notice provides more information regarding the applicant's participation in the conference.

5. Option to Propose Amendment

The response under 37 CFR 1.116 included with a P3 request optionally may include a proposed amendment to a claim(s). Entry of any proposed amendment after a final Office action is governed by 37 CFR 1.116. See MPEP 714.12. In addition, a proposed amendment under the P3 may not broaden the scope of a claim in any aspect. For the purposes of the P3, the analysis of whether a proposed amendment to a claim impermissibly would broaden the scope of the claim will be analogous to the guidance set forth in section 1412.03 of the MPEP for determining whether a reissue claim has been broadened.

A proposed amendment that focuses the issues with respect to a single independent claim is the type of proposed amendment that provides the best opportunity for leading to the application being placed into condition for allowance. A proposed amendment that contains extensive amendments (either in terms of the nature of the amendment or number of claims to be amended) probably will require extensive further consideration and thus likely would not be effective to place the application in condition for allowance. Extensive amendments will be considered only to the extent possible under the time allotted to the examiner under the P3.

The sheet(s) of the response containing a proposed amendment will not count towards the five-page limit discussed at Section II.A.3 of this notice. In accordance with 37 CFR 1.121(c)(1), the sheet(s) of the response containing the proposed amendment may not contain arguments.

B. P3 Procedures

1. Technology Center Review

After receipt of a P3 request, the relevant technology center will review the request to verify that it is timely, includes a transmittal form, a response under 37 CFR 1.116 comprising no more than five pages of arguments (exclusive of any proposed amendment), and the conference participation statement, and otherwise complies with the requirements of the P3 set forth at Section II.A of this notice. If the request is timely and compliant, the technology center will contact the applicant to schedule the conference.

If the review finds that the request is untimely or otherwise fails to comply with the requirements of the P3, a conference will not be held. The response and any proposed amendment filed with the request will be treated under 37 CFR 1.116 in the same manner as any non-P3 response to a final rejection (except that if the request fails to comply because a P3 request previously has been accepted in response to the same final rejection, the response and any proposed amendment will be entered only if the examiner requests them, as mentioned earlier at Section II.A of this notice). The next communication issued by the Office will indicate the reason that the request was found to be untimely or

otherwise non-compliant, the result of the treatment under 37 CFR 1.116 of the response and any proposed amendment filed with the request, and the time period for the applicant to take any further action that may be required as dictated by the facts. For example, if the response and any proposed amendment filed together with an untimely or otherwise non-compliant P3 request fails to place the application in condition for allowance, the next Office communication will be an advisory action. On the other hand, if the response and any proposed amendment is enterable under 37 CFR 1.116 and places the application in condition for allowance, the next Office communication will be a notice of allowability.

If the review of a P3 request finds that the request is timely and complies with the requirements of the P3, but the technology center reviewing the request has reached its limit of 200 compliant requests accepted, a conference will not be held. In this situation, the response and any proposed amendment filed with the request will be treated under 37 CFR 1.116 in the same manner as any non-P3 response to a final rejection. The Office may need to take appropriate measures to adjust an examiner's workload if the volume of requests for a P3 conference with any particular examiner becomes excessive.

It is critical for P3 participants to understand that the filing of a P3 request will not toll the six-month statutory period for reply to the final rejection. To avoid abandonment, further action, such as the filing of a notice of appeal or RCE, will need to be taken within the six-month statutory period for responding to the final rejection, unless the

applicant receives written notice from the Office that the application has been allowed or that prosecution is being reopened.

2. The Post-Prosecution Pilot Conference

After the Office initially verifies that a P3 request is timely and compliant as discussed at Section II.B.1 of this notice, a Supervisory Patent Examiner (SPE) (preferably the SPE of the examiner of record) will coordinate a panel experienced in the relevant field of technology to review the response under 37 CFR 1.116 filed with the P3 request. The panel may include the examiner of record, the SPE, and a primary examiner (preferably the signing primary examiner for the examiner of record, if the examiner of record is a junior examiner). Every reasonable attempt will be made to select panel members with the most expertise in the relevant technological and legal issues raised by the application under consideration.

Concurrently, the Office will contact the applicant to schedule the conference. The applicant may arrange to participate in-person, by telephone, or by a video conferencing tool, such as WebEx®. Although the Office will make every reasonable attempt to accommodate the applicant and timely schedule the conference, scheduling of the conference lies within the full discretion of the Office. If within ten calendar days from when the Office first contacts the applicant, the Office and the applicant are unable to agree on a time to hold the conference, or if the applicant declines to participate in the conference, the request will be deemed improper and treated in accordance with the

discussion at Section II.B.1 of this notice. If the examiner of record is unable to participate on the scheduled date of the conference and rescheduling is not possible, the conference will proceed and the other conferees will gather input from the examiner prior to the conference if possible. The remaining conferees may, at their discretion, opt to include in the panel another examiner from the pertinent art.

The conference will begin with the applicant's presentation, which is limited to 20 minutes. The applicant will be excused from the conference at the end of the presentation. Any materials used by the applicant during the presentation, e.g., a PowerPoint® or exhibit, will be placed in the file and will not count against the five-page limit on arguments. Entry of an affidavit or other evidence included as part of the presentation materials is governed by 37 CFR 1.116. See MPEP 714.12.

The applicant may present on appealable, not petitionable, matters (e.g., applicant may not present an argument that the final rejection was premature). The applicant may present arguments directed to the outstanding record, and, if the response filed with the P3 request includes a proposed amendment, the applicant also may present arguments directed to the patentability of the amended claim(s).

3. The Notice of Decision from Post-Prosecution Pilot Conference

The applicant will be informed of the panel's decision in writing via the mailing of a Notice of Decision from Post-Prosecution Pilot Conference (form PTO-2324). For an

accepted P3 request (refer to Section II.B.1 of this notice for the procedure that will be followed for an untimely or non-compliant P3 request), the notice of decision will indicate one of the following: (a) Final rejection upheld; (b) allowable application; or (c) reopen prosecution. In appropriate circumstances, a proposed amendment may accompany the notice of decision proposing changes that, if accepted, may result in an indication of allowability.

a. Final Rejection Upheld

If the notice of decision indicates “final rejection upheld,” the notice of decision will not contain any additional grounds of rejection or any restatement of a previously made rejection. Instead, the notice of decision will summarize the status of the pending claims (allowed, objected to, rejected, or withdrawn from consideration) and the reasons for maintaining any rejection, and include an indication of any rejection that has been withdrawn as a result of the conference.

For a P3 request that includes a proposed amendment as part of the response under 37 CFR 1.116, a notice of decision indicating “final rejection upheld” also will communicate the status of the proposed amendment for purposes of appeal (entered/not entered). If the proposed amendment is entered for purposes of appeal, and the notice of decision indicates which individual rejection(s) set forth in the final Office action would be used to reject the amended claim(s), then any subsequent examiner’s answer may

include the rejection(s) of the amended claim(s), and such rejection(s) made in the examiner's answer would not be considered a new ground of rejection.

If a notice of decision indicates "final rejection upheld," the time period for taking further action in response to the final rejection expires on (1) the mailing date of the notice of decision; or (2) the date set forth in the final rejection, whichever is later. As discussed previously, to avoid abandonment, the applicant must file a notice of appeal or RCE within the statutory period for response to the final rejection. Extensions of time may be obtained under 37 CFR 1.136(a), but the period for response may not be extended beyond the six-month statutory period for response.

A notice of decision indicating "final rejection upheld" is not petitionable. A decision to maintain a rejection is subject to appeal. Accordingly, the Office will not grant a petition seeking reconsideration of a panel decision upholding the final rejection. The applicant maintains the right of appeal under 35 U.S.C. 134 by filing a notice of appeal and an appeal brief and having the appeal considered by the PTAB.

b. Allowable Application

If the notice of decision indicates "allowable application," the notice of decision will be mailed concurrently with a Notice of Allowance, and the notice of decision will state that the rejection(s) is/are withdrawn

c. Reopen Prosecution

If the notice of decision indicates “reopen prosecution,” the notice of decision will state that the rejection(s) is/are withdrawn and a new Office action will be mailed. The notice of decision also will state that no further action is required by the applicant until further notice.

4. Actions that Will Terminate a Post-Prosecution Pilot Conference

If the applicant files any of the following after the date of filing a P3 request, but prior to a notice of decision from the panel of examiners, processing of the P3 request will end without a decision on the merits of the P3 request: a notice of appeal; a RCE; an express abandonment under 37 CFR 1.138; a request for the declaration of interference; or a petition requesting the institution of a derivation proceeding. The response and any proposed amendment filed with the request will be treated under 37 CFR 1.116 in the same manner as any non-P3 response to a final rejection. The next communication issued by the Office will indicate the reason that processing of the P3 request was terminated, the result of the treatment under 37 CFR 1.116 of the response and any proposed amendment filed with the request, and the time period for the applicant to take any further action that may be required as dictated by the facts.

In addition, as stated earlier, once a P3 request has been accepted in response to a final rejection, no additional response under 37 CFR 1.116 to the same final rejection will be entered, other than one that the examiner has requested because the examiner agrees it

would place the application in condition for allowance. This condition of the P3 holds true regardless of whether the additional response is filed prior to, on the same day as, or after a notice of decision from the panel of examiners.

Finally, at any point during the processing of a P3 request, the examiner may enter an Examiner's Amendment placing the application in condition for allowance.

III. Request for Comments

The Office has three main goals for the P3: (1) Increase the value of after final practice; (2) reduce the number of appeals and the issues to be taken on appeal to the PTAB and the number of RCEs; and (3) streamline the options available to an applicant during after final practice. The Office is requesting public comment on the P3 and other suggestions to improve after final practice and reduce the number of both appeals and issues taken up for appeal to the PTAB and RCEs. The Office plans to evaluate the public feedback and the balance between the degree to which the P3 achieves its goals and the examining resources it expends. The Office will provide advance notification before modifying and/or extending the P3 or making the P3 permanent.

Dated: July 7, 2016.

Michelle K. Lee,

*Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office.*

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